

Application No. 10/770,721

REMARKS**Introductory Comments**

Prior to this Amendment, claims 1-20 are pending in this application. By this Amendment, Applicants have amended claims 1, 8, and 15, and have cancelled claims 5 and 18 without prejudice or disclaimer of the subject matter contained therein.

Applicants do not acquiesce in the Examiner's rejections, but instead have elected to make the above-mentioned amendments in an effort to expedite prosecution of this application leading to issuance of a patent. Reconsideration of the application as amended above and in view of the following remarks is earnestly solicited.

Priority and Specification Objections Under 35 U.S.C. §§ 120 and 132

In the Official Action, the Examiner asserts that the Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120. Specifically, the Examiner asserts that the present application is not a continuation of the applications listed for priority within the specification because it contains new matter. As such, the Examiner objected to the specification under 35 U.S.C. § 132, asserting that the last two paragraphs of the specification together with Figures 21 and 22 constitute new matter.

Applicants respectfully disagree with the Examiner's assertion that new matter has been added to the present application. The information of which the Examiner asserts constitutes new matter (i.e., the last two paragraphs of the present specification and Figs. 21 and 22) is disclosed within U.S. Patent No. 5,715,548 (see columns 61-62 and Figs. 21 and 22), which is a cross-referenced and prior patent in the same chain as the present application. (See Applicants' specification, p. 1, line 16). U.S. Patent No. 5,715,548 was expressly incorporated by reference into the present application. (See Applicants' specification p. 1, ll. 18-19).

As Applicants have properly incorporated by reference the disclosure of U.S. Patent No. 5,715,548, as well as the other application disclosures contained within this related family chain (see page 1, lines 5-19 of the present application), the present application is a proper continuation application of the applications listed for priority and does not contain any new matter. Accordingly, Applicants respectfully request that the instant objection be withdrawn.

Claim Rejections**35 U.S.C. § 112, First Paragraph**

Claims 6-14 and 20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More particularly, the Examiner asserts that the limitations concerning the position of the foot section as being positioned between the siderails when in a lowered position (claim 6), the relative widths of the siderails with regards to one another (claims 7-10, 13 and 14), and the mattress step portion (claim 20) are not supported by the disclosures of the applications relied upon for priority, and are thus new matter. As explained in detail above, Applicants have properly incorporated by reference the disclosure of U.S. Patent No. 5,715,548 (as well as the other application disclosures contained within the related family chain) in which the support for claims 6-14 can be found, for example at col. 61-62 describing Figs. 34-35. As such, claims 6-14 and 20 do not constitute new matter and the Examiner's rejection under 112, first paragraph has been overcome. Applicants therefore respectfully request that the rejection be withdrawn.

Claim 20 is further rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully submit that the subject matter of claim 20 is adequately described to satisfy the enablement requirement in Figs. 21 and 22. Figs. 21 and 22 clearly show mattress 20 having an upper portion and a lower portion, wherein the upper portion has a perimeter that is greater than the perimeter of the lower portion of mattress 20. Accordingly, Applicants respectfully request that this rejection be withdrawn.

35 U.S.C. § 112, Second Paragraph

Claim 8 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claim 8 is amended as shown in the Listing of Claims to clarify the claimed subject matter to overcome this rejection.

Applicants respectfully request that the rejection of claim 8 under 35 U.S.C. § 112 be withdrawn in view of the above-described amendment.

35 U.S.C. § 102(b) - Feldt

Claims 1 and 3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Feldt (U.S. Patent No. 4,682,376).

Applicants respectfully submit that Feldt simply does not support the Examiner's

rejection under § 102(b) in light of the amendments and arguments made in this response. The case law is clear on this point, "anticipation requires that a single prior art reference disclose every limitation of the patent claim." General Electric Co. v. Nintendo Co., 50 USPQ2d 1910, 1915 (Fed. Cir. 1999) (citing PPG Industries, Inc. v. Guardian Industries Corp., 37 USPQ2d 1618, 1624 (Fed. Cir. 1996)) ("to anticipate a claim, a reference must disclose every element of the challenged claims and enable one skilled in the art to make the anticipating subject matter."). More particularly, the Federal Circuit has held that the test for anticipation is "[t]hat which would literally infringe if later in time anticipates if earlier than the date of invention." Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 3 USPQ2d 1776 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

Independent Claim 1

The Examiner has failed to establish a *prima facie* case of anticipation by failing to particularly point out the elements in Feldt which allegedly correspond to each of the limitations of claim 1. In particular, Feldt fails to teach or suggest a patient support combination having first and second siderails moveable between a raised position and lowered position underneath the deck, as required by claim 1.

Therefore, Applicants believe that claim 1 is in condition for allowance with respect to Feldt. Removal of the rejection and allowance of claim 1 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where these limitations are expressly disclosed.

Dependent Claim 3

Claim 3 depends from independent claim 1. In that claims 1 is believed to be allowable, as discussed above, claim 3 is also believed to be allowable. Removal of the rejection and allowance of claims 1 and 3 is respectfully requested.

35 U.S.C. § 102(b) – Johnston et al

Claims 1-4, 15, 17 and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Johnston et al (U.S. Patent No. 4,409,695).

Independent Claims 1 and 15

The Examiner has failed to establish a *prima facie* case of anticipation by failing to particularly point out the elements in Johnston et al which allegedly correspond to each of the limitations of amended claims 1 and 15.

With regard to claim 1, Johnston et al fail to teach or suggest a patient support having first and second siderails moveable between a raised position and lowered position underneath the deck, as required by amended claim 1.

Regarding claim 15, Johnston et al fails to teach or suggest a mattress configured for support by a deck, the deck comprising a first portion defining a first thickness and a second portion defining a second thickness, wherein the first thickness is greater than the second thickness, as required by amended claim 15.

Therefore, Applicants believe that claims 1 and 15 are in condition for allowance with respect to Johnston et al. Removal of the rejection and allowance of claims 1 and 15 is respectfully requested. If the Examiner should disagree with the Applicant's arguments, the Examiner is asked to kindly point out with particularity where these limitations are expressly disclosed.

Dependent Claims 2-4, 17 and 19

Claims 2-4 depend from independent claim 1 and claims 17 and 19 depend from independent claim 15. In that claims 1 and 15 are believed to be allowable, as discussed above, claims 2-4, 17 and 19 are also believed to be allowable. Removal of the rejection and allowance of claims 2-4, 17 and 19 is respectfully requested.

35 U.S.C. § 102(b) – Weismiller et al

Claims 1-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Weismiller et al (U.S. Patent No. 5,715,548).

As is explained in detail above, U.S. Patent No. 5,715,548 is a cross-referenced and expressly incorporated application directed related to and part of the same chain of patents as the present application. More particularly, Applicants have incorporated by reference the disclosure of U.S. Patent No. 5,715,548, as well as the other application disclosures contained within this related family chain expressly within the present specification (See page 1, lines 5-19). Accordingly, Applicants respectfully request that this rejection is improper and should be withdrawn by the Examiner. Reconsideration is respectfully requested.

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Final Comments

Applicants submit that the application is now in condition for allowance and respectfully request that the same be granted. Applicants request that, if necessary, this Amendment be considered a request for an extension of time for a time appropriate for the amendment to be timely filed. Applicants request that any required fees for filing this Amendment be charged to the account of Bose McKinney & Evans LLP, Deposit Account Number 02-3223.

Respectfully submitted,

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